

R E M A R K S

Careful review and examination of the subject application are noted and appreciated.

SUPPORT FOR CLAIM AMENDMENTS

Support for the amendments to the claims can be found in the drawings as originally filed, for example, in FIGS. 1a-3 and in the specification as originally filed, for example, on page 5, line 10 through page 9, line 16, and on page 10, line 7 through page 12, line 4. As such no new matter has been added.

CLAIM OBJECTIONS

Although the Office Action mailed December 30, 2003 did not contain an objection to claim 9, the Examiner indicates in the Advisory Action that claim 9 is now objected to because the preposition "to" is used instead of the preposition "for." Although Applicant's representative does not necessarily agree with the Examiner's requirement to "change 'to' to --for--" (see page 2, section no. 1 of the Addendum to the Advisory Action), claim 9 has been amended as suggested by the Examiner in an effort to materially advance the application toward allowance.

CLAIM REJECTIONS UNDER 35 U.S.C. §112

The rejection of claims 1-20 under 35 U.S.C. §112, second paragraph, has been obviated by appropriate amendment and should be withdrawn. Although Applicant's representative does not necessarily agree with the Examiner's statements that: "Footprint variations cannot be eliminated where there is first no prior recitation of their creation," "Layout variations cannot be eliminated where there is no prior recitation of their creation," and "Layout and footprint changes cannot be reduced where there is first no prior recitation of their existence" (see page 3, lines 1-10 of the Office Action mailed December 30, 2003; see also page 2, section no. 3, of the Addendum to the Advisory Action mailed May 12, 2004), claims 1, 19 and 20 have been amended as suggested by the Examiner in an effort to materially advance the application toward allowance.

Specifically, claims 1, 19 and 20 have been amended to include an earlier reference to layout variations and footprint variations which the Examiner's statements appear to require to provide "structural cooperative relationships" (see page 3, lines 1-10 of the Office Action mailed December 30, 2003; see also page 2, section no. 3, of the Addendum to the Advisory Action mailed May 12, 2004). In particular, claim 1 now recites "A method for generating a superset pinout for a family of devices **having potential footprint variations**, comprising the steps of:"

Claim 19 now recites "An apparatus for generating a superset pinout for a family of devices **having layout variations** comprising:"

Claim 20 now recites "a device configured to generate a superset pinout for a family of devices **having layout and footprint variations**, wherein"

Furthermore, the rejection of claim 19 with respect to the phrase "said superset pinout" lacking prior antecedent basis (see page 2, section no. 3, lines 9-10 of the Addendum to the Advisory Action mailed May 12, 2004) was overcome by the response filed March 24, 2004 (see page 2 of the Advisory Action). As such, claims 1, 19 and 20 are fully patentable under 35 U.S.C. §112, second paragraph, and the rejection should be withdrawn. Furthermore, since no other rejections are pending with regard to claims 1, 19 and 20, claims 1, 19 and 20 are in condition for allowance.

Although the Office Action mailed December 30, 2003 did not contain a specific basis for rejection of claim 3 other than the dependence of claim 3 on claim 1, the Examiner indicates in the Advisory Action that claim 3 is now rejected because it "fails to set forth the subject matter that Applicant claims as his invention." No factual evidence or convincing line of reasoning is presented to support such a conclusion (see page 2, section no. 3, lines 9-10 of the Addendum to the Advisory Action mailed May 12, 2004). Although Applicant's representative does not necessarily agree with the Examiner's conclusory statement, claim 3 has been

amended in an effort to materially advance the application toward allowance. As such, claim 3 is believed to be fully patentable under 35 U.S.C. §112, second paragraph. Furthermore, since no other rejections are pending with regard to claim 3, claim 3 is in condition for allowance.

Although Applicant's representative does not necessarily agree with the Examiner's statement with respect to claim 10 that "it is unclear to what late changes will be allowed; furthermore 'without external components' is a dangling phrase and seem [sic] unrelated to the rest of the claim" (see page 3, lines 1-3 of the Addendum to the Advisory Action), claim 10 has been amended in an effort to materially advance the application toward allowance. As such, claim 10 is believed to be fully patentable under 35 U.S.C. §112, second paragraph. Furthermore, since no other rejections are pending with regard to claim 10, claim 10 is in condition for allowance.

Claims 2-4, 6-11, 13-18 depend, either directly or indirectly, from claim 1 which is believed to now be allowable. As such, the presently claimed invention is fully patentable under 35 U.S.C. §112, second paragraph, and the rejection should be withdrawn.

SHOWING UNDER 37 CFR § 1.116(b)

Entry of the above amendments after a final rejection is

proper under 37 CFR §1.116(b). Specifically, the amendments made are believed to comply with requirements of form expressly set forth in the final Office Action mailed December 30, 2003 (see page 3, lines 1-10 of the Office Action mailed December 30, 2003, page 2, section no. 3, of the Addendum to the Advisory Action mailed May 12, 2004 and page 3, lines 6-8 of the Interview Summary by Matthew S. Smith dated May 20, 2004; paper no. 05202004). Therefore, the amendments are believed to put the application in condition for allowance. Furthermore, the amendments put the claims in better form for consideration on appeal by obviating the grounds of rejection cited in the final Office Action. For the above reasons entry of the above amendments is believed to be proper under 37 CFR §1.116(b). As such, the amendments should be admitted and the application allowed.

RECONSIDERATION OF FINALITY OF THE OFFICE ACTION
MAILED December 30, 2003

Applicant's representative respectfully requests reconsideration of the finality of the Office Action mailed December 30, 2003. Specifically, the Office Action stated:

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office Action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP §706.07(a). (see section no. 8, pages 3-4 of the Office Action mailed December 30, 2003).

However, the amendments which resulted in the final Office Action

involved (i) adding subject matter of claim 5 which had been indicated as being allowable to claim 1, (ii) adding subject matter similar to claim 6 which had been indicated as being allowable to claim 19 and (iii) adding subject matter of claim 18 which had been indicated as being allowable to claim 20 (see paragraph nos. 20 and 21 on page 5 of the Office Action dated July 14, 2003 and claims 18 and 20 on pages 5-6 and page 8, lines 5-8 of the Amendment filed October 2, 2003). Since the Office Action (i) stated that claims 5, 6 and 18 contained allowable subject matter (see paragraph no. 20 on page 5 of the Office Action dated July 14, 2003) and (ii) indicated reasons the subject matter was considered allowable (see paragraph no. 21 on page 5 of the Office Action dated July 14, 2003), it does not appear to be proper to penalize the Applicant for trying to claiming what he is justly entitled to based upon that which the Examiner indicated was allowable.

In particular, MPEP §706.07 states:

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. **The applicant who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application. But the applicant who dallies in the prosecution of his or her application, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary**

examiner, can no longer find a refuge in the rules to ward off a final rejection (MPEP § 706.07, emphasis added).

Furthermore, MPEP §706.07 states:

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, **the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied;** and in reply to this action **the applicant should amend with a view to avoiding all the grounds of rejection and objection.** Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination, i.e., either an allowance of the application or a final rejection (MPEP § 706.07, emphasis added).

Clearly, since the Examiner **should have thoroughly searched the invention as disclosed and claimed in the first action and fully applied the references,** the Applicant, by incorporating subject matter indicated by the Examiner as being allowable, is **seeking to define the invention in claims that will give the patent protection to which he or she is justly entitled by amending with a view to avoiding all the grounds of rejection and objection.** Therefore, the Applicant should receive the cooperation of the Examiner to that end, and not be prematurely cut off in the prosecution of the application. As such, Applicant's representative respectfully

requests that the finality of the previous Office Action be withdrawn.

SUMMARY OF TELEPHONE INTERVIEW

In a telephone interview on May 20, 2004, the Examiner's Supervisor Matthew Smith and Applicant's representative, Robert Miller, discussed the Advisory Action mailed May 12, 2004 in light of Applicant's representative belief that an agreement had been reached that a new Office Action would be issued. Examiner Smith stated that the Advisory Action was technically an Office Action. Applicant's representative pointed out that the amendment which resulted in the final Office Action had involved taking subject matter indicated to be allowable (see paragraph nos. 20 and 21 on page 5 of the Office Action dated July 14, 2003 and page 8, lines 5-8 of the Amendment filed October 2, 2003). Examiner Smith indicated he felt the Advisory Action was clear¹ and that what was needed to provide the structural connection the Examiner asserted was missing was an earlier reference to the layout variations and footprint variations in the claims. Examiner Smith stated that the options available were filing another Amendment After Final to address the Examiner's concerns or Appeal.

¹ Except for the reference to claim 12 which had been cancelled and the reference to the antecedent basis of "said superset pinout" in claim 19 which was obviated by the previous response.

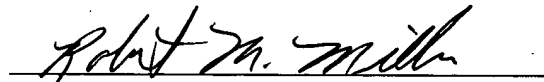
Accordingly, the present application is in condition for allowance. Early and favorable action by the Examiner is respectfully solicited.

The Examiner is respectfully invited to call the Applicant's representative, Robert Miller, should it be deemed beneficial to further advance prosecution of the application.

If any additional fees are due, please charge our office Account No. 50-0541.

Respectfully submitted,

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Dated: May 27, 2004

Docket No.: 0325.00503